FILED
OCT 31 1901
JAMES H. MCKENNEY

Brief of Wells for Respondents.
Filed Oct. 31, 1901.

Supreme Court of the United States.

OCTOBER TERM, 1901.

No. 444

JOHN A. BRILL and the J. G. BRILL COMPANY,
Complainants and Petitioners,

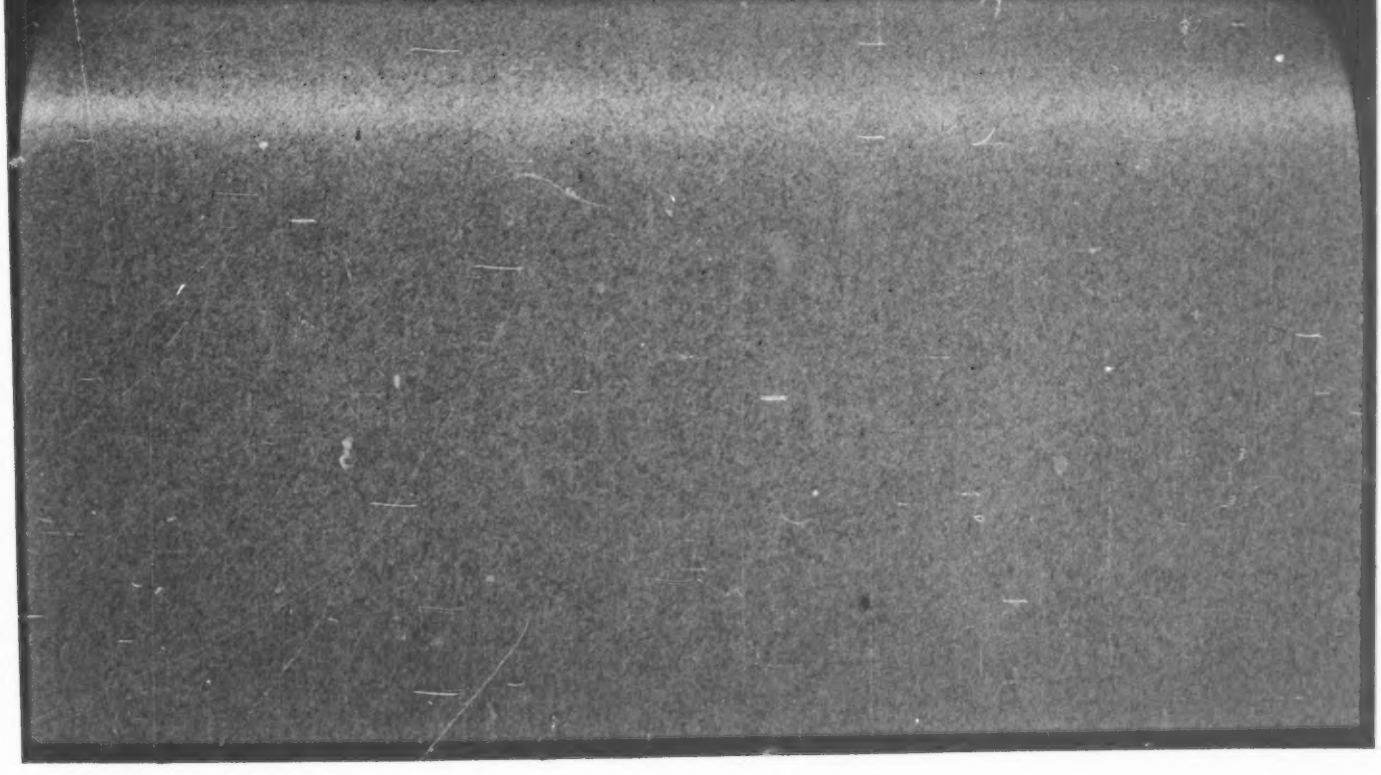
vs.

THE PECKHAM MOTOR TRUCK AND WHEEL COMPANY, *et al.*,
Defendants and Respondents.

On Writ of Certiorari to the United States Circuit Court of Appeals for the Second Circuit.

BRIEF FOR RESPONDENTS.

HENRY P. WELLS,
Counsel for Respondents.



Supreme Court of the United States.

OCTOBER TERM, 1901.

JOHN A. BRILL and the J. G. BRILL COMPANY, Complainants and Petitioners, *against* THE PECKHAM MOTOR TRUCK & WHEEL COMPANY, EDGAR PECKHAM, W. G. PRICE, ERWIN G. LONG and THEODORE SPORE, Defendants and Respondents.	**In Equity. (Patent Suit.)**

Respondents' Reply to Complainants' Brief and Petition for Certiorari.

By far the greater part of the Petitioners' Petition and Brief relate to matters which the decision of the Circuit Court of Appeals for the Second Circuit shows were not considered by said Appellate Court, and had no influence upon its decision.

But two points are material to the question whether this petition shall be granted or denied.

First.—Is this case one in which, under the settled practice of this Court, it will intervene by the writ of certiorari?

If it is not, that of course ends the matter. If it is, then the following point alone comes up for consideration:

Second.—Did the reasons assigned by the said Circuit Court of Appeals justify it in dismissing the Bill of Complaint?

FIRST.

IS THIS CASE ONE IN WHICH, UNDER THE SETTLED PRACTICE OF THIS COURT, IT WILL INTERVENE BY THE WRIT OF CERTIORARI?

The Rule, as laid down in American Construction Co. *vs.* Jacksonville T. & K. W. R. Co., 148 U. S., 372-378, is as follows:

> "In any such case as is hereinbefore made "final in the circuit court of appeals, it shall "be competent for the Supreme Court to re- "quire, by certiorari or otherwise, any such "case to be certified to the Supreme Court for "its review and determination, with the same "power and authority in the case as if it had "been carried by appeal or writ of error to the "Supreme Court, has been held to be a branch "of its jurisdiction which should be exercised "sparingly and with great caution, and only "in cases of peculiar gravity and general im- "portance. *Re* Lau Ow Bew, 141 U. S., 583 "and 144 U. S. 47; *Re* Woods, 143 U. S. 202."

In Forsythe *v.* Hammond, 166 U. S., 506-520, this Court reaffirmed this Rule, saying:

> "It is a power which will be sparingly exer- "cised, and only when the circumstances of "the case satisfy us that the importance of "the question involved, the necessity of avoid- "ing conflict between two or more circuit "courts of appeal, or between courts of ap- "peal and the courts of a state, or some matter "affecting the interests of this nation in its in- "ternal or external relations, demands such "exercise."

See also Castner *v.* Coffman, 178 U. S., 168-184.

This is believed still to be the Rule of this Court.

Does this case fall within the confines of this Rule? It does not. It is but a plain patent suit in Equity in which the Petitioners sued the Respondents for infringement of a patent for a street car truck, and no question of law was involved not theretofore settled by this Court.

SECOND.

DID THE REASONS ASSIGNED BY THE CIRCUIT COURT OF APPEALS JUSTIFY IT IN DISMISSING THE PETITIONERS' BILL OF COMPLAINT?

That Court said to the Petitioners in effect: We have compared your patent as it stands with the Defendants' alleged infringing device as you yourselves describe it, and we find it impossible on the face of your patent to bring the Defendants' device within its scope. You cannot, therefore, ultimately prevail, and consequently we dismiss your Bill of Complaint under the authority of Mast, Foos & Co. *v.* Stover, 177 U. S. 485.

The decision in the case at Bar is reported in 108 F. R. p. 267. The following extracts define the Court's position. The opinion was written by Judge WALLACE.

> "If the first and second claims of the patent
> "in suit (letters patent to George M. Brill,
> "No. 478,218, dated July 1, 1892) require a
> "construction limiting the combination
> "therein specified to one in which the spiral
> "springs and elliptical springs are so arranged
> "that the latter are not brought into action
> "until after the former have begun to com-
> "press, the car trucks of the defendant do
> "not infringe the claims. In the car trucks
> "of the defendant both sets of springs are
> "brought into action, and begin to compress
> "simultaneously when the weight upon them

"is greater than the normal weight of the car.
" * * *

"If the patentee had attempted to do so, it
" would have been difficult to frame a specifi-
" cation which more industriously sets forth
" as essential to his invention such a construc-
" tion and arrangement of the spring devices
" that the elliptic springs will not be brought
" into play until the spiral springs have been
" compressed by the weight of the car body
" and added load, 'until the weight of the load
" 'on the axle-box springs begins to depress
" 'said springs abnormally.' This character-
" istic of the invention must be imported into
" the claims, and would have to be if the
" qualifying term, 'substantially as de-
" 'scribed,' had not been incorporated into
" them. * * *

"The case is one in which it is apparent that
" the complainant cannot ultimately prevail,
" and following the practice sanctioned by Mast,
" Foos & Co. *v.* Stover Mfg. Co., 177 U. S.
" 485, 20 Sup. Ct. 708, 44 L. Ed. 856, one in
" which the bill should be dismissed."

SOME ERRORS OF FACT IN THE PETITIONERS' PAPERS.

First.—The Petitioners state in Italics on page 2 of their Petition,

"The Complainants *were not permitted, un-*
" *der the rules of practice of the said Court,*
" *to file counter affidavits relating to new mat-*
" *ter set up in defendants' affidavits.*"

This statement is repeated on pages 16 and 20 of the Petition, and on pages 2, 9 and 18 of the accompanying brief.

This is a mistake. There is no such rule of practice in the Second Circuit. The Rule is as follows:

"Rule 107. Suppletory, or supporting, "proofs may, at the discretion of the Court, "or judge, be offered by the complainant, to "rebut the cause as shown by the defendant; "but the reception of such additional proofs "is not to permit the introduction of further "proofs in opposition thereto, by the defend- "ant, previous to the final hearing upon the "merits."

Second.—On page 16 of the Petition and elsewhere it is stated that the Appellate Court

"struck down this important and valuable "patent."

This brief statement contains two errors. The Court "struck down" nothing except the Complainants' unwarranted pretensions. It did not pass upon the validity of the patent, nor has it at any time been argued that the patent is invalid.

The patent is neither "important" nor "valuable". The depositions showed that the Complainants had abandoned making the car truck shown and described in the Patent, for over three years before suit.

The allegation that the trucks of the Patent superseded all others and came into general favor, so often repeated in the Petition and Brief, is the product of a lively imagination based on the unwarranted assumption that all trucks designed to prevent galloping, no matter by whom made nor how, were covered by the Patent in Suit, notwithstanding that trucks constructed to prevent galloping were patented before complainants' application and invention dates. Trucks of all makes were taken in, including those of the Defendants, of which Petitioners' papers admit that over 10,000 were in use when suit was begun. The depositions showed that four out of every five cars in use on Broadway, New York, were on the Defendants' trucks, and the same was true on many other street car roads. The master mechanic of the Third

Avenue Street Railway in New York City deposed that he had used on that road the trucks of Complainant and Defendant in direct and simultaneous competition; that he had trouble with the Complainants' trucks, and none with the Defendants; and that when the road was changed from cable to electricity the Complainants' trucks were thrown into the scrap heap, while Defendants' trucks were equipped with electric motors and continued in use.

The Complainants' contention that the Patent in Suit conferred a great boon on the general public, and that they are being deprived by the Second Circuit Court of Appeals of their due reward, has no foundation in fact. They are entitled to no sympathy on this score.

No parole testimony can overthrow the Decision of the Court that the Complainants cannot ultimately prevail, based, as it is, on the limitations of the Patent and its File Wrapper, and the obvious radical differences in construction and mode of operation shown by the drawings and models of Defendants' Structure.

One insuperable fact confronts the Complainants, and it is fatal to any argument addressed to the reversal of the Decision of the Appellate Court dismissing the Bill.

This insuperable obstacle is the specific and oft-repeated description of the construction and mode of operation of Complainants' device in the specification of the Patent, and irrevocably affirmed by the construction the Patentee himself placed upon his invention in the Patent Office to differentiate it from references cited in rejection.

The specification calls for the combination in a car truck of spiral springs placed near the axle-boxes, and elliptic springs placed between the extended ends of the truck frame, so combined that with an ordinary load on the car the whole weight is borne upon the spiral springs alone; and not until the load upon the car is "abnormal" do the elliptic springs come into action at all.

The specification also calls for elliptic springs rigidly fastened below to the truck frame, but above not even in contact with the car body under the normal conditions of use.

The only provision to overcome "galloping," aside from the mythical alleged breaking up of the rythm of the spring system, is cushioning the descending end of the car body upon the elliptic springs at the descending end, the rising end of the car body being left unrestrained to move as it will.

In the language of the Decision of the Appellate Court,

> "If the patentee had attempted to do so it "would have been difficult to frame a specifi- "cation which more industriously sets forth as "essential to his invention such a construction "and arrangement of the spring devices that "the elliptic springs will not be brought into "play until the spiral springs have been com- "pressed by the weight of the car body and "the added load, 'until the weight of the "'load on the axle-box springs begins to "'depress said springs abnormally.' This "characteristic of the invention must be "imported into the claims, and would have to "be if the qualifying terms 'substantially as "'described' had not been incorporated into "them."

The Defendants' structure was before the Court, both in drawings and models. These drawings were put in by the Complainants as proof of Defendants' structure. The Court saw that the mod-

els strictly conformed to these drawings. Both drawings and models when compared with the Patent-in-Suit, showed beyond possibility of doubt that Defendants' structures differed radically both in construction and in mode of operation from that of the Patent-in-Suit.

On the one hand stand the specification and drawings of the Patent itself.

On the other hand stand the Defendants' structures.

The Patent and these structures speak for themselves. They are themselves the very best evidence because they are the things themselves. No testimony of any number of witnesses, expert or otherwise, can vary or overcome what these exhibits conclusively demonstrate upon their face.

Unless the specification of the Patent be first rewritten, and the confirmatory construction repeatedly given his invention by the Patentee to avoid references cited against his application in the Patent Office, be first blotted out, by no possibility of extrinsic evidence, until this has been done, does any other conclusion seem possible than that arrived at in the Decision; to wit,

"*The case is one in which it is apparent that the complaint cannot ultimately prevail.*"

If this be so, would it not be a cruel injustice to subject these Defendants to the delay, the annoyance, and the heavy expense of a protracted patent litigation, in which one side or the other would surely appeal, when the ultimate result is a foregone conclusion?

Judge Shipman's Decision in the Third Avenue Case.

The reference to Judge Shipman's Decision in the Third Avenue Case, contained in Complain-

ants' Petition would seem to be wholly immaterial.

In the case before Judge Shipman the Defendant's truck was a *Chinese copy* of the Patent-in-Suit. If the Patent presented any element of validity, a clear case of infringement was presented. In the present suit Defendants' structure is radically different, both in construction and in mode of operation, from the Patent-in-Suit (see *post* page 14).

The questions here presented, therefore, necessitated an analysis of Complainants' specification, and a consideration of its specific limitations and its history in the Patent Office, wholly uncalled for in the Third Avenue case.

Rule of Comity.

On page 11 of Petitioners' Brief we find:

"II.—The Court below did not give 'sufficient "'weight' to the Rule of Comity, and therefore "the decree was reversible error.

> "The proper scope of the 'Rule of Comity' "and its application by Circuit Courts of Ap- "peal is stated in the opinion of this Court in "the Mast-Foos case. We submit that the "present case, as presented to the Circuit "Court of Appeals, was one in which the rule "was peculiarly applicable and should have "been applied, and that the refusal of the "Court below, under the circumstances, was "reversible error."

Respondents' counsel is at loss to understand how the petitioners can find any support for this proposition in the Mast-Foos case. The portion of that decision touching on this point would seem to be perfectly clear and explicit, and dead against the Petitioners.

It seems a singular proposition that, on the ground of comity, it is reversible error for a Cir-

cuit Court of Appeals to reverse one of its own Circuit Judges when the whole record is before it, as was the whole Third Avenue Record in the case at bar, it having been introduced by the Complainants.

THE DEFENDANT PECKHAM'S PATENT, 419,876.

As to the Defendant Peckham's Patent, 419,876, it is difficult to see how it could be interpreted otherwise than as in the Decision of the Court.

The elaborate argument on page 25 *et seq.* of the Petitioners' Brief, that the combination of the Patent-in-Suit supports the corners of the car better than does that of this Peckham Patent, would seem to be quite immaterial. The question is not whether this Peckham Patent anticipates the Patent-in-Suit, but whether it limits by showing the combination of elliptic and spiral springs in a Car Truck to overcome galloping. The drawings and specifications of this Peckham Patent show and describe this combination, and the specification states explicitly it is for that very purpose. How could this Court decide otherwise than that this Peckham Patent precluded any broad subsequent claims for this combination, and limited the Complainants to their own construction ?

It is suggested in the Petition and Brief that Claim 1 of the Patent in Suit recites as an element a stationary frame, and that the invention is therein distinguished from Peckham patent 419,876 which shows an axle box frame suspended from the pedestals by short links and therefore, flexibly supported. The specifications of the Patent in Suit, however, makes it quite immaterial whether the axle box frame is rigidly or flexibly supported from the saddles or pedestals. On Page 1 therein, lines 20-25 *et seq.*, it is said :

> "In my structure I mount upon the axle-
> "boxes, either rigidly *or flexibly*, what are
> "known in the art as 'sidebeams,' which
> "singly or when united laterally form a frame
> "which is not affected either by the up-and-
> "down vibrations of the car-body or movable
> "portion of the truck."

The contention, on page 39 of the Petitioners' Brief, that the Petitioners should have opportunity to offer testimony and be heard on the question whether Complainants' date of invention did not precede the filing date of this Peckham Patent 419,876, and also that of the Manier Patent, must be an inadvertence.

The Complainants' Counsel would hardly have raised this point had they not forgotten that the Patentee himself swore in his affidavit on application for the injunction in this case (Record p. 75–76), that the first working drawings of the Structure of the Patent in Suit were made December 8th, 1890, and its first mechanical embodiment was in January, 1891.

In Judge SHIPMAN's decision in the Third avenue case (Record p. 234) he says:

> "Although the patentee conceived the idea
> "of the invention of Claims 1 and 2 in May,
> "1889, and made rough sketches of it, he laid
> "it aside and did not take it up again until
> "November, 1890."

The filing date of Peckham Patent 419,876, as appears on the face of the patent, was September 2, 1889; and that of the Manier patent was June 21st, 1889.

Moreover the Peckham patent was cited as an anticipation during the progress of the Patent-in-Suit through the Patent Office. The Applicant admitted it to be part of the prior art by endeavoring to differentiate it from his application. Not the slightest intimation was then made that his date of invention preceded the reference.

But however all this may be, in view of the expressed limitations of the Patent in Suit and the radical differences in construction and mode of operation of the Defendants' structures, hereinafter in part specified, it would seem of little consequence, as far as the question now before the Court is concerned, whether that Peckham Patent anticipates or limits the Patent-in-Suit—or indeed whether it ever existed.

CLAIMS 9, 10, 11 AND 14 OF THE PATENT-IN-SUIT.

As to the suggestion contained in the Petition that if the Complainants were allowed to introduce testimony they might bring Defendants' structure under Claims 9, 10, 11 and 14 of the Patent-in-Suit, it may be stated that those claims are equally handicapped by the limitations of the specification; and, as hereinbefore stated, from these limitations they cannot escape unless the specification be first rewritten.

It is to be noted that in Claim 9 we find the following words:

> "And a plurality of springs located between
> " the stationary and movable frames, some of
> " said series being adapted to be compressed
> " by the downward movement of said movable
> " frame *subsequent to the compression of*
> " *other of the series, substantially as de-*
> " *scribed.*"

In Claim 10 we find:

> "Springs located between the ends of both
> " frames, and springs otherwise disposed be-
> " tween the two frames, *the end springs being*
> " *adapted to be compressed subsequent to the*
> " *compression of the other springs, substan-*
> " *tially as described.*"

Also in Claim 11 we find:

> "*The elliptical springs being adapted to be*
> "*brought into action subsequent to the*
> "*springs supporting the movable frame, sub-*
> "*stantially as described.*"

Also in Claim 14 we find:

> "*And spiral springs for supporting the car*
> "*body, supplemented by elliptical springs*
> "*adapted to co-act therewith, the spirals being*
> "*adapted to be compressed prior to the*
> "*ellipticals, substantially as described.*"

From this would it not seem impossible to bring Defendants' structure within the scope of these claims by any conceivable testimony, since the specification and the terms of the claims all limit the Patent to this successive action of the springs, *an arrangement wholly absent from Defendants' structure.*

Further Answer Unnecessary.

In view of the foregoing, an analytical answer to the other points in Complainants' Petition and Brief would seem to be idle.

Until Complainants can perform the impossible feat of re-writing the specification of the Patent-in-Suit, and suppressing its File Wrapper, is it not impossible by any conceivable verbal testimony to bring Defendants' structure within its scope?

Complainants' and Defendants' Structures Compared.

In the following comparison of Complainants' and Defendants' structures all points not shown by a mere comparison of the Patent-in-Suit and the drawings and models of Defendants' structure have

been ignored; that is to say, *all points requiring testimony for their support have been omitted.*

In the case of the Union Steam Pump Co. *vs.* Battle Creek Co., 104 F. R., 337-342, the Sixth Circuit Court of Appeals said:

> "If, however, such changes of size, form or "location effect a change in the principle or "mode of operation such as breaks up the "relation and co-operation of the parts, this "results in such a change in the means as dis-"places the conception of the inventor and "takes the new structure outside of the patent "(Citing Brooks *v.* Fisk, 15 How., 212-221; "Mfg. Co. *v.* Brill, 54 F. R., 380-384. 9th C. C. "A.; Gould *v.* Reeves, 15 Wall., 187-193)."

See also Westinghouse *v.* Boyden, 170 U. S., 537-569, which says:

> "But, after all, even if the patent for a ma-"chine be a pioneer, the alleged infringer must "have done something more than reach the "same result. He must have reached it by "substantially the same or similar means, or "the rule that the function of a machine can-"not be patented is of no practical value. To "say that the patentee of a pioneer invention "for a new mechanism is entitled to every me-"chanical device which produces the same re-"sult is to hold, in other language, that he is "entitled to a patent for his function. Mere "variations of form may be disregarded, but "the substance of the invention must be "there."

If this be the law in regard to a pioneer invention, how much more stringent must be its application to an invention of the limited character of that of the Patent-in-Suit?

THE COMPARISON.

THE PATENT-IN-SUIT:

On page 1, lines 62-65 of the Specification we read: "the spiral springs, which are supported by

or about the axle boxes, normally take the weight of the car."

IN DEFENDANTS' STRUCTURE the weight of the car is *borne at all times upon all the springs.*

THE PATENT-IN-SUIT:

On page 1, line 66 of the Specification we find that the elliptical springs are to be placed between the upper chord (the car-body) and the truck-frame, and are so arranged as not to be brought into action until the weight of the load on the axle-box springs begins to depress said springs "*abnormally.*" Then, and not until then, the elliptic springs begin to act.

DEFENDANTS' STRUCTURE:

In this all the springs, both spiral and elliptic, are confined between the car body and truck frame, and are held thereto rigidly, top and bottom. They must all move simultaneously, therefore, and one cannot come into action before the other.

It is as though all the Defendants' springs were simultaneously confined between the jaws of a vice, one extremity of each of the springs being rigidly fastened to the fixed jaw of the vice, and the opposite extremities of each spring being fastened to the movable jaw of the vice. Thus, whether the jaws of the vice are brought together or separated, each and every spring *must* expand or be compressed simultaneously and to the same extent irrespective of its strength or character:

THE PATENT IN-SUIT:

On page 1 of the Specification, lines 101, *et seq.*,

we find that the elliptics are so constructed and placed that they shall be called into action and aid the spirals to resist only "*the abnormal*" depression of the car.

DEFENDANTS' STRUCTURE:

In this all the springs must at all times act simultaneously and in unison, whether the car is empty or loaded to the limit of its capacity.

THE PATENT-IN-SUIT:

On page 2 of the Specification, line 116 *et seq.*, we find that the elliptic springs are not to come into play until after the axle-box springs have begun to compress; and that the action of the spirals in lifting the car-body is continued after the elliptic springs have ceased to act. We also find in the File Wrapper that the Patentee limited himself to this particular combination and coaction of his springs, in order to avoid references cited against the claims alleged to be infringed in this suit, among them the Defendant Peckham's own Patent, No. 419,876.

DEFENDANT'S STRUCTURE:

Therein all the springs are compressed and react simultaneously.

THE PATENT-IN-SUIT:

On page 3, line 25 *et seq.* of the Specification, we find that while the elliptic springs are rigidly secured to the truck-frame, they are not at all secured to the car-body. Thus they can exercise no control over any upward movement of the car-body.

DEFENDANTS' STRUCTURE:

Therein the elliptic springs are rigidly secured below to the truck-frame and above to the car-body, and partake of and aid in controlling every motion of the car-body.

THE PATENT-IN SUIT:

From a further examination of the Specification, we find that the car-body when "galloping" is spring cushioned only at the descending end, the ascending end being left absolutely free from restraint.

DEFENDANTS' STRUCTURE:

Therein the motion of the car-body is always spring cushioned and tied down at both ends, both when the car-body ends are rising as well as descending.

THE PATENT-IN-SUIT:

At page 3 of the Specification, line 69 *et seq.*, we find that when the loading is not excessive, the ordinary action of the car-body is all taken up on the spiral springs; and that the elliptics then act merely as buffers to cushion the descending motion at the descending end of the car-body when the car gallops.

DEFENDANTS' STRUCTURE:

Therein this is not so, since all of its springs are *held top and bottom and are always in action.*

THE PATENT-IN-SUIT:

The "*spring-base*" is the distance between the centers of the two springs which are nearest the ends and on the same side of the car.

The "*wheel-base*" is the distance between where the wheels on the same side of the car touch the track.

The spring-base of the truck of the Patent-in-Suit, under normal conditions, when the load is wholly carried on the spiral springs, is far shorter than the spring-base of the Defendants' trucks; since then the spring-base of Complainants' trucks is but the distance from the center of one spiral spring near the axle-boxes to the other on the same side of the car.

DEFENDANTS' STRUCTURE:

In Defendants' trucks, the spring-base is always the distance between the outermost springs at the extreme ends of the car and therefore much longer. The tendency to oscillate, therefore, is far greater and less controlled in the Complainants' than in the Defendants' trucks.

THE PATENT-IN-SUIT:

We find in the specification that under normal conditions of load the car is carried on the spiral springs alone. On page 3, line 70, it is stated:

> "When the excessive loading is not present, "the springs on the ends of the side beams "[the elliptics] act as buffers, the ordinary ac- "tion of the car body on the truck being taken "up by the spiral springs."

Thus under these circumstances, Complainants' truck is one having a very short spring-base (but

little longer than the wheel-base) which invites "galloping," and their method is confined to an endeavor to subdue the galloping at the descending end only of the car by the buffer action of the elliptic springs at that end car; the ascending end being unchecked or uncontrolled in any way.

DEFENDANTS' STRUCTURE:

Therein the spring-base is always substantially as long as the extended truck frame, and the arrangement and mode of operation is such as to meet and check galloping at its very inception at both ends of the car. Defendants' construction is preventive; Complainants' construction permits the development of the disease and then seeks to cure it.

THE PATENT-IN-SUIT:

The galloping motion is alleged to be obviated by the employment of springs of different character and of opposed periods of oscillation, thus breaking up their rhythm.

DEFENDANTS' STRUCTURE:

Therein this difficulty is met and overcome by the introdnction of underlying springs, which resiliently tie down both ends of the car-body, so that neither end can rise, as it must in galloping, without lifting the weight of the entire truck frame and all its appendages; and this the galloping tendency lacks the power to do.

The construction is this. Bolts are rigidly fastened to the extreme ends of the car body. These pass loosely down through and project beyond the under side of the truck frame. There they terminate in a large head, between which head and the under side of the truck frame spiral

springs—" the underlying springs "—are placed. Thus when either end of the car body begins to rise, as it must do in the process of galloping, these spiral springs are compressed and resist the motion. They are so regulated that not until they are fully compressed is the motion of moment. But when the underlying springs are fully compressed, then the bolts, being rigidly secured to the car body above and bearing rigidly against the under side of the truck frame below, the car body is solidly locked to the truck frame and cannot rise any more without lifting the weight of the truck frame, motor, axles and the wheels, which is beyond the power of the galloping tendency to do.

It is to be noted that these underlying springs have absolutely no counterpart in the Patent-in-Suit.

Contrast this simple mechanical common-sense device, with Complainants' visionary theory that in the Patent in Suit galloping is obviated by breaking up the rhythm of the springs.

THE PATENT-IN-SUIT:

The critical differences between Complainants' and Defendants' constructions may be made to further appear by considering their modes of operation, not at one moment of time when one end of the car is descending and the other ascending, but during a longer period in which the results of that action are observable. In Complainants' structure when, from an uneveness of the track or an obstruction thereon or from other cause, an impulse is imparted to the car body which causes it to gallop, or oscillate longitudinally, the car body being entirely free and unrestrained at its ends, the descending end strikes, with considerable

energy perhaps, upon the tops of the elliptic springs, delivering a hammer-like blow and more or less compresses them. The natural recoil of the car-body after such an impact supplemented by the reaction of the compressed elliptic springs, throws that end of the car up with more or less violence, and its other end descends delivering a blow upon the other elliptic springs, which thereby are compressed. This end of the cars now recoils in like manner, and the tetering back and forth continues until gradually the carbody again assumes its normal position of equilibrium, in which it is supported (unless the load be abnormal) solely by the spiral springs adjacent the axle-boxes.

THE DEFENDANTS' STRUCTURE:

In Defendants' structure the long spring-base, substantially equal to the length of the extended truck frame, at all times supports the car body at its ends as well as adjacent to the axle-boxes; and therefore the tendency to the rocker-like or "galloping" motion is reduced to a minimum. Should an impulse be imparted to the car body *tending* to produce "galloping," the tendency for one end of the car to rise is met and subdued in its incipiency by the underlying springs and bolts provided at that end for that purpose; and such increased downward pressure of the other end of the car upon the elliptic springs, supporting it at all times, is merely incidental, just as is shown in the Defendant Peckham's Patent No. 464,253 (which was before the Court and which antedates the Patent in Suit both in filing (Oct. 30th, 1890) and issue dates)—indeed it was filed before Complainants earliest date of invention, Dec. 8th, 1890. At no time is the Defendants' car body uncontrolled or unrestrained at its ends, and free to rock through an arc of any dimensions however small. Whereas

in the structure of the Patent iu Suit the car body is absolutely uncontrolled and unrestrained at its ends from rocking through an arc, the amplitude of which is determined by the normal space intervening between the tops of the elliptic springs and the car body or the guiding shoes thereon.

CONCLUSION.

If these differences appear from the mere comparison of the Patent in Suit and the drawings and models of the Defendants' structure, how can any conceivable additional testimony bring a structure so radically different in construction and mode of operation as the Defendants', within the scope of that Patent?

These considerations would seem to irresistibly bring the impartial mind to the conclusion expressed in the Decision of the Appellate Court.

"THE CASE IS ONE IN WHICH IT IS APPARENT THAT THE COMPLAINANTS CANNOT ULTIMATELY PREVAIL."

If the rule laid down by the Supreme Court in the Mast-Foos case is ever to be applied, why should it not be applied in this case? What case can be more extreme than this?

If the following language of the Supreme Court in that case does not apply to this case, to what case can it apply?

> "But if the bill be obviously devoid of "equity upon its face, and such invalidity be "incapable of remedy by amendment * * "* * we know of no reason why to save a

"protracted litigation, the court may not order
"the bill to be dismissed * * * * *or if*
"*no question be made regarding the identity*
"*of the alleged infringing device and it ap-*
"*pears clear that such device is not an in-*
"*fringement*, and no suggestion be made of
"further proofs upon the subject, we think
"the Court should not only overrule the order
"for the injunction but dismiss the bill."

(The italics are ours.)

Three points are here called for. If these are found in favor of the Defendants, "*The Court * * * * should dismiss the bill.*"

First: The identity of the alleged infringing device should be clear.

This has not been questioned by either side.

Second: It should "appear clear that such device is not an infringement."

On comparison of Defendants' Structure with the Patent in Suit construed in accordance with the limitations contained in its specification, does it not appear clear that Defendants' device is not an infringement?

Third: That "no suggestion be made of further proofs upon the subject."

This means, of course, pertinent proof, reasonable proof, proof which will tend to cause doubt in a reasonable mind upon the question of infringement.

The best possible evidence in this case is the comparison of the Patent in Suit with the Defendants' Structure. Is it not impossible to suggest any secondary evidence, any parole evidence, any "further proofs," which can overthrow what

is thus shown—that it is impossible to bring the Defendants' Structure within the scope of the Patent in Suit?

This comparison presents not the slightest difficulty. The matter involved is not unusual, technical or abstruse; and, therefore, is not one in which the Court might be aided by expert testimony, as, for instance, in a case involving chemical reactions or the mathematics of electricity. To make it the Court needs not the slightest assistance. A thousand experts could not make the matter more clear. *No future evidence can add to or subtract one word from the Patent, nor a bolt or nut from the Defendants' Structure.* It is the test of this comparison which the Complainants must successfully meet. No testimony, or suggestion of testimony, on any other point can avail them.

The Courts have not unfrequently dismissed a bill on demurrer because of lack of invention in the Patent in Suit apparent upon the face of the papers. The fundamental principle is the same. The Mast-Foos case merely extends this principle to cover cases where the patent and proofs on appeal from a motion granting a preliminary injunction show that the Complainant cannot ultimately prevail in the suit. In the Case at Bar this is shown by comparison of the Complainants' Patent and their own proof of what Defendants' device was.

The Mast-Foos case is perhaps the most beneficent patent decision of recent years. It gives prompt protection to the weak when assailed with unwarranted demands by the strong based upon prior decisions where the issues were not the same. It can do no injustice to any man. The rights of a Defendant to protection against an unjust demand, are as dear to this Court as the rights of a Com-

plainant to enforce a just demand; and the more speedily and with the least cost an unjust demand can be suppressed, the more nearly the administration of justice approaches the ideal.

In the Case at Bar the specification of the Patent and its file-wrapper over and over, and then again and again, persistently insist that the invention resides in a certain structure involving a certain successive action of the spiral and elliptic springs, and the claims require that the combination and operation of the spiral and elliptic springs shall be as so described.

Do the Defendants use that combination and mode of operation? From the complainants' own proof of what the Defendants' device was, the Appellate Court decided that the Defendants did not.

That is the only question, and to that question but this one answer is possible.

If these things be so, would it not be most inequitable to compel these defendants to pay thousands of dollars, little of which they can ever recover, to litigate a question of infringement, the only possible answer to which is already apparent?

THE PETITION SHOULD BE DENIED.

All of which is respectfully submitted.

HENRY P. WELLS,
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New York, October 24th, 1901.

NOTE.—The Consolidated Fastener Case, 100 F. R., 984, cited at the bottom of page 13, of the Petition, was decided February 28th, 1900. The Mast-Foos case was decided by the Supreme Court on April 23d, 1900, and of course supersedes the Fastener case.